

**REMARKS**

Applicants respectfully contend that the finality of the present office action mailed 06/17/2005 is improper under MPEP 706.07(a) because the Examiner introduced new grounds of rejection not necessitated by Applicants' response (filed 05/31/2005) to the office action mailed 04/01/2005. In particular, Applicants did not amend any claim in Applicants' office action response filed 05/31/2005.

Applicants further contend that the Examiner's argument that mailed 06/17/2005, namely that "Applicant's amendment filed on 11/29/2004 necessitated the new grounds) of rejection presented in this Office action" has no bearing on whether or not the present office action can be a final office action.

Accordingly, Applicants respectfully request that the office action mailed 06/17/2005 be changed from a final office action to a non-final office action.

The Examiner objected to claim 18, because there are two periods at the end of the claim sentence. In response, Applicants have amended claim 18 to delete one of the two periods at the end of the claim sentence.

The Examiner rejected claims 1-2, 5-8, 10-12, 15-18, and 20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe et al. (hereinafter Pepe), US 5,673,322, in view of Gauvin et al. (hereinafter Gauvin), US 5,790,800 and Banavar (hereinafter Banavar), US 6,662,206.

The Examiner rejected claims 3 and 13 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, Gauvin, and Banavar as applied to claim 1 and 11, and further in view of Batra, US 6,105,067.

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The Examiner rejected claims 4 and 14 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, Gauvin, and Banavar as applied to claims 1 and 11, and further in view of van Landegem et al. (hereinafter van Landegem), US 5,265,091.

The Examiner rejected claim 19 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, Gauvin and Banavar as applied to claim 18 above, and further in view of O'Connell et al. (hereinafter O'Connell), US 6,661,787.

The Examiner rejected claims 9 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, US 5,673,322, in view of Gauvin et al. (hereinafter Gauvin), US 5,790,800, and O'Connell et al. (hereinafter O'Connell), US 6,661,787.

Applicants respectfully traverse the §103(a) rejections with the following arguments.

35 U.S.C. §103(a)Claims 1-2, 5-8, 10-11 15-18, and 20

The Examiner rejected claims 1-2, 5-8, 10-12, 15-18, and 20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe et al. (hereinafter Pepe), US 5,673,322, in view of Gauvin et al. (hereinafter Gauvin), US 5,790,800 and Banavar (hereinafter Banavar), US 6,662,206.

Applicants respectfully contend that claims 1 and 11 are not unpatentable over Pepe in view of Gauvin and Banavar, because Pepe in view of Gauvin and Banavar does not teach or suggest each and every feature of claims 1 and 11.

As a first example of why claims 1 and 11 are not unpatentable over Pepe in view of Gauvin and Banavar, Pepe in view of Gauvin and Banavar does not teach or suggest the feature: "intercepting, by a client interceptor acting on behalf of a server application, a second-protocol data communication request from a client application" (claim 1) and "a client interceptor acting on behalf of the server application, said client interceptor adapted to intercept a second-protocol data communication request from the client application" (claim 11).

The Examiner argues: "Pepe did not specifically teach that the local proxy is a client interceptor, the remote proxy is the server interceptor .... Gauvin taught to use interceptors in intercepting the requests (col.2, lines 38-42, col.9, lines 5-7, col.12, lines 57-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Pepe and Gauvin because Gauvin's teaching of using interceptors help to implement the proxies of Pepe's method to intercept requests and establish communications (Gauvin, col,

12, lines 57-63)."

In response, Applicants respectfully contend that the Examiner's suggestion of modifying Pepe to incorporate Gauvin's alleged teaching of interception is not supported in Gauvin. In particular, Gauvin, col. 8, line 66 - col. 9, line 7 recites: "A problem exists. The prior art software processes and data structures necessary to establish and maintain a communication circuit between the client applications 210 and a servers 111-113 assume that the circuit 131 is extant. However, for mobile client applications 210 making a request of the servers 111-113, this may not be true. Therefore, the present invention, as a solution provides for the interception of client application requests. The requests are intercepted by the interceptor 700."

Thus, Gauvin teaches interception of client requests to account for the possibility that circuit 131 in FIG. 1 of Gauvin may not be extant. However, there is no teaching in Pepe of the possibility of a circuit, such as Gauvin's circuit 131, as not being extant. Therefore, the motivation for teaching interception of client requests in Gauvin does not carry over to Pepe.

As a second example of why claims 1 and 11 are not unpatentable over Pepe in view of Gauvin and Banavar, Pepe in view of Gauvin and Banavar does not teach or suggest the feature: "compensating a disadvantageous characteristic of the first protocol, said compensating comprising ascertaining that a condition exists and eliminating the condition in response to said ascertaining, said condition being a connection condition or a transmission capacity condition" (claim 1) and "means for compensating a disadvantageous characteristic of the first protocol, said compensating comprising ascertaining that a condition exists and eliminating the condition in response to said ascertaining, said condition being a connection condition or a transmission capacity condition" (claim 11).

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The Examiner argues: "Banavar taught to detect that a condition exists and eliminate the condition in response to said detection (col.8, lines 3-8; known technique for detecting lost connection and re-establishing connection), It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Pepe, Gauvin and Banavar because Banavar's teaching of determining broken connections and reestablishing connections enables Pepe and Gauvin's method to monitor connections and re-establish the loss connections."

In response, Applicants respectfully contend that Banavar cannot be used as prior art in rejecting claims of the present patent application, because "[e]ffective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention 'were, at the time the invention was made, owned by the same person or subject to assignment by the same person.'" MPEP 706.02(1)(1). First, the present patent was filed on May 15, 2001 which is after November 29, 1999. Second, the Banavar patent is being considered by the Examiner as prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(c), because the Banavar patent issued on December 9, 2003 which is after the filing date of May 15, 2001 of the present patent application. Third, both the subject matter of Banavar patent and the claimed invention of the present patent application were, at the time the invention was made, owned by International Business Machines Corporation or subject to assignment by International Business Machines Corporation. Accordingly, Applicant respectfully maintains that Banavar cannot be used as a prior art reference.

Based on the preceding arguments, Applicants respectfully maintain that claims 1 and 11

are not unpatentable over Pepe in view of Gauvin and Banavar, and that claims 1 and 11 are in condition for allowance. Since claims 2, 5-8, and 10 depend from claim 1, Applicants contend that claims 2, 5-8, and 10 are likewise in condition for allowance. Since claims 15-18 and 20 depend from claim 11, Applicants contend that claims 15-18 and 20 are likewise in condition for allowance.

#### Claims 3 and 13

The Examiner rejected claims 3 and 13 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, Gauvin, and Banavar as applied to claim 1 and 11, and further in view of Batra, US 6,105,067.

The Examiner rejected claim 3 and 13 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe and Gauvin as applied to claims 1 and 11, and further in view of Backstrom et al., US 6,570,881.

Since claims 3 and 13 respectively depend from claims 1 and 11, which Applicants have argued *supra* to not be unpatentable over Pepe in view of Gauvin and Banavar under 35 U.S.C. §103(a), Applicants maintain that claims 3 and 13 are likewise not unpatentable over Pepe, Gauvin, and further in view of Batra under 35 U.S.C. §103(a).

#### Claims 4 and 14

The Examiner rejected claims 4 and 14 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe and Gauvin to claims 1 and 11, and further in view of van Landegem et al., US 5,265,091.

The Examiner rejected claims 4 and 14 under 35 U.S.C. §103(a) as allegedly being

unpatentable over Pepe, Gauvin, and Banavar as applied to claims 1 and 11, and further in view of van Landegem et al. (hereinafter van Landegem), US 5,265,091.

Since claims 4 and 14 respectively depend from claims 1 and 11, which Applicants have argued *supra* to not be unpatentable over Pepe in view of Gauvin and Banavar under 35 U.S.C. §103(a), Applicants maintain that claims 4 and 14 are likewise not unpatentable over Pepe, Gauvin, and Banavar and further in view of Landegem under 35 U.S.C. §103(a).

In addition, Pepe, Gauvin, and Banavar and further in view of Landegem does not teach or suggest the feature: "wherein the ascertaining comprises determining that transmission capacity is insufficient to process the data communication request **within a predetermined interval of time**, and wherein the eliminating comprises establishing a parallel connection to increase transmission capacity" (emphasis added).

The Examiner argues: "As per claims 4 and 14, Pepe, Gauvin, and Banavar taught the invention substantially as claimed in claims 1 and 11. Pepe further taught wherein the act of compensating further comprises the acts of determining that transmission capacity is insufficient process the data communication request (col.9, lines 26-32). Pepe, Gauvin, and Banavar did not specifically teach herein the act of compensating further comprises the acts of determining the transmission capacity to process the data communication request within a predetermined interval of time, and establishing a parallel connection to increase transmission capacity. van Landegem taught to determine the transmission capacity with a predetermined interval of time and to establish a parallel connection to increase transmission capacity (col.12, lines 15-40, 52-63, col. 14, lines 54-61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Pepe, Gauvin and van Landegem because van Landegem's teaching of determining transmission capacity and establishing parallel connection

helps Pepe and Gauvin's method to determine bandwidth availability in a periodic basis in a connectionless environment (e.g., first protocol, col.2, lines 14-19)".

In response, Applicants respectfully contend that Landegem (col.12, lines 15-40, 52-63, col. 14, lines 54-61) does not teach or suggest "determining the transmission capacity to process the data communication request **within a predetermined interval of time**". Applicants contend that the "predetermined interval of time" taught by Landegem to determine transmission capacity (i.e., bandwidth) is not the "predetermined interval of time" recited in claims 4 and 14. In fact, any given "predetermined interval of time" can be used to calculate the bandwidth, simply by dividing the given "predetermined interval of time" by the cell count (see Landegem, col. 12, lines 29-38). In contrast, the "predetermined interval of time" recited in claims 4 and 14 is being used to determine whether the transmission capacity is sufficient to process the data communication request of claims 4 and 12.

For example, assume that the data communication request is required to be processed in 2 seconds and that processing the data communication request requires transmitting 10,000 bytes of data. For this example, a transmission capacity of 5,000 bytes/sec is required to process the data communication request in a predetermined interval of time of 2 seconds. In order to determine whether the actual transmission capacity is sufficient for this purpose (as is required in claims 4 and 14), one must compare the actual transmission capacity with the required transmission capacity of 5,000 bytes/sec. Therefore, one must know the actual transmission capacity. Landegem teaches using a predetermined interval of time to calculate the actual transmission capacity. Thus, the predetermined interval of time (e.g., 10 seconds, 60 seconds, etc.) used to calculate the actual transmission capacity is unrelated to the "predetermined interval of time" of claims 4 and 14.



The point is that the "predetermined interval of time" taught by Landegem relates to calculating the actual transmission capacity, whereas the "predetermined interval of time" in claims 4 and 14 relates to determining whether the actual transmission capacity is sufficient for satisfying the predetermined data transmission capacity requirement (i.e., 5000 bytes/sec in this example) for processing the data communication request of claims 4 and 14.

In "Response to Arguments", the Examiner makes the following allegation as part of the Examiner's argument to support modifying Pepe with the alleged teaching of van Landegem: "Pepe taught to determine if the transmission capacity is insufficient to process the data communication, request (col.9, lines 26-32)."

In response, Applicants note that Pepe, col.9, lines 26-32 does not relate to whether or not to process the data communication request from the client as required in claims 4 and 14, but rather relates to whether or not to process *the response* of the server to the data communication request of the client. Therefore, the Examiner's argument appears to be misdirected and thus unpersuasive.

Accordingly, Applicants respectfully contend that the Examiner has failed to establish a *prima facie* case of obviousness in relation to claims 4 and 14.

#### Claim 19

The Examiner rejected claim 19 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, Gauvin and Banavar as applied to claim 18 above, and further in view of O'Connell et al. (hereinafter O'Connell), US 6,661,787.

Since claim 19 depends from claim 11, which Applicants have argued *supra* to not be unpatentable over Pepe in view of Gauvin and Banavar under 35 U.S.C. §103(a), Applicants

maintain that claim 19 is likewise not unpatentable over Pepe, Gauvin and Banavar and further in view of O'Connell under 35 U.S.C. §103(a).

In addition, Pepe in view of Gauvin and further in view of O'Connell does not teach or suggest the feature: "means for receiving, by the client interceptor, an identification of the server application". The Examiner alleges that Gauvin teaches the preceding feature of claim 9 in col. 9, lines 61-67; col. 10, lines 1-19.

Applicants cite Gauvin, col. 10, lines 15-16 which states that "... port and server identifications, are provided in step 820". Moreover, Gauvin, col. 10, lines 8-11 teaches that the interceptor intercepts the execution flow of steps 810, 820-850. Thus, the interceptor in Gauvin executes step 820. Applicants note that step 820 recites "providing" server identifications. Thus, by executing step 820, the interceptor executes "providing" server identifications. However, claims 4 and 14 require "receiving" a server identification. Applicants maintain that "providing" a server identification is the exact opposite of "receiving" a server identification. Therefore, Gauvin does not disclose the preceding feature of claim 19.

In addition, Applicants respectfully maintain that the Examiner's argument with respect to O'Connell is an improper modification of the secondary reference of Gauvin. The Examiner argues that the primary reference of Pepe discloses most of the features of claim 19. The Examiner also argues that the secondary reference of Gauvin has modified the primary reference of Pepe, by alleging that Gauvin teaches or suggests "receiving ... an identification of the server application" (emphasis added). The Examiner additionally argues that the secondary reference of O'Connell has modified the secondary reference of Gauvin, by alleging that O'Connell teaches or suggests "forwarding the identification to an address-resolution server ..." (emphasis added). Applicants maintain that it is improper to argue that a claim feature is taught or

suggested by a secondary reference through modification of another secondary reference. If the Examiner could modify a secondary reference in the preceding manner, then the Examiner would be able to show the existence of any element or feature of any claim merely by chaining a sufficient number of secondary references together in the preceding manner. Accordingly, Applicants respectfully maintain that the rejection of claim 19 under 35 U.S.C. §103(a) is improper and should be withdrawn.

#### Claim 9

The Examiner rejected claim 9 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, Gauvin and Banavar as applied to claim 18 above, and further in view of O'Connell et al. (hereinafter O'Connell), US 6,661,787.

The Examiner rejected claims 9 under 35 U.S.C. §103(a) as allegedly being unpatentable over Pepe, US 5,673,322, in view of Gauvin et al. (hereinafter Gauvin), US 5,790,800, and O'Connell et al. (hereinafter O'Connell), US 6,661,787.

Since claim 9 depends from claim 1, which Applicants have argued *supra* to not be unpatentable over Pepe in view of Gauvin and Banavar under 35 U.S.C. §103(a), Applicants maintain that claim 9 is likewise not unpatentable over Pepe in view of Gauvin and further in view of O'Connell under 35 U.S.C. §103(a).

In addition, Pepe in view of Gauvin and further in view of O'Connell does not teach or suggest the feature: "receiving, by the client interceptor, an identification of the server application", based on the same arguments presented *supra* by Applicants in conjunction with claim 19.

**CONCLUSION**

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account 09-0457.

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